

REMARKS/ARGUMENTS

The Office Action has been carefully considered. The issues raised are traversed and addressed below with reference to the relevant headings and paragraph numbers appearing under the Detailed Action of the Office Action.

Specification

The Applicants have amended a paragraph at Pages 1 and 2 of the specification to correct a typographical error. The Applicants submit that this amendment introduces no new matter.

Double Patenting

The Examiner has raised a provisional double patenting rejection with regard to claims 1, 13, 24 and 30 and are intervening claims in view of claims 1, 15, 28 and 39 of Application No. 10/291,821. The Applicant assumes that by "intervening" the Examiner has not raised the rejection against claims 35 to 38, and thus, in view of the amendments made to claim 1 (as discussed below) the provisional double patenting rejection is moot.

Additionally, the Examiner has raised a statutory rejection to claims 1, 17, 31, 43, 54 and 56 and intervening claims of the present application in view of claims 1, 5, 16 of U.S. Patent No. 6,644,645. The Applicant respectfully requests clarification of this rejection on the claims previously pending on this application were claims 1 to 38. In any event, the Applicant submits that due to the amendments made to the claims (as discussed below), the statutory-type double patenting rejection is also moot.

Claim Rejections 35 USC § 102

In view of the claims amendments, and the discussions below, the claim rejections under this section are now moot.

Claim Rejections 35 USC § 103

Claim 1 of the present application has been amended to include the subject matter of claim 35. Accordingly, claim 35 has been cancelled from the application.

The Examiner has rejected claim 35 as the Examiner believes that claim 35 is unpatentable over Wolff (US Patent No. 6,081,261) in view of Sekendur (US Patent No. 5,477,012).

The Applicant respectfully submits that the amended claim 1 is patentable over Wolff in view of Sekendur.

In particular, it will be appreciated that, as stated in MPEP 2143:

to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Applicant respectfully submits that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify Wolff with Sekendur, or to combine the reference teachings in order to obtain the claim limitations.

In particular, Wolff is directed towards reading pre-printed barcodes used for identifying document pages and other application defined areas (see abstract, column 10 line 6). However, as asserted by the Examiner on pages 10 to 11 of the Office Action, Wolff does not describe indicating data including time varying position information regarding movement of the sensing device relative to the form. Wolff only describes determining movement of the pen instrument due to sensing the motion of the pen instrument and forces applied thereto (see column 9 line 27 to column 10 line 10).

In any event, the Examiner has stated that Sekendur describes obtaining time varying position information regarding the movement of the sensing device by sensing coded data and not the forces applied to the pen instrument, as in Wolff. Thus, the Applicant respectfully submits that as Sekendur teaches away from the teaching of Wolff, then Sekendur cannot be combined with Wolff. In particular, the Applicant highlights MPEP 2143.01 which states:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

Therefore, as Wolff determines movement of the sensing device by sensing forces applied to the sensing device, and Sekendur determines movement of the sensing device by sensing coded data, it would not be obvious for a person skilled in the art to combine Wolff with Sekendur.

The Applicant also respectfully highlights the following passage from MPEP 2143 (in reference to *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991):

the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art.

Furthermore, MPEP 2143.01 states:

the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Therefore, as there is no suggestion or teaching in the prior art references themselves, and as Wolff and Sekendur teach away from each other, and the references do not suggest the desirability of the combination, a person skilled in the art would not combine Wolff with Sekendur, and thus, the amended claim 1 is not prima facie obvious.

In any event, the present amended claim 1 describes the coded data of a form being indicative of the identity of the form, position information of the sensing device relative to the form, and time varying position information regarding movement of the sensing device relative to the form. It will be appreciated by the Examiner that a combination of Wolff and Sekendur does not describe these claims limitations.

In particular, if a person skilled in the art were to combine Wolff with Sekendur, the combination would describe the barcode of Wolff, having identity information and the co-ordinates of Sekendur, from which the pen may determine movement. The combination of Wolff and Sekendur would therefore require two types of coded data, and two separate actions from a sensing device.

Thus, a sensing device would sense the barcode in order to obtain the identity of the page, and then proceed to sense co-ordinates such that the movement of the pen can be determined.

The amended claim 1, however describes the coded data being indicative of the identity of the form, at least one reference point of the form, and the time varying position information of the sensing device. Thus, the sensing device of claim 1 may obtain the identity of the form, at least one reference point of the form and the time varying position information in just one action of sensing coded data.

Hence, as the combination of Wolff and Sekendur does not teach all of the claim limitations, the present amended claim 1 is patentable over Wolff in view of Sekendur.

In any event, to further clarify these distinctions over the cited prior art, the Applicant has also added claims 39 to 42 to the application, which describe that the coded data includes coded data portions, where each coded data portion is indicative of the at least one reference point of the form and the identity of the form. It will be appreciated by the Examiner that this feature of claims 39 to 42 is not shown in any of the prior art documents. A basis for this amendment is shown in Figure 5.

Similar amendments have been made to independent claims 13, 24, and 30, with claims 36 to 38 being cancelled from the application, and similar arguments apply with respect to these other independent claims.

In light of the above, it is respectfully submitted that the objections and claim rejections have been successfully traversed and addressed. The amendments do not involve adding any information that was not already disclosed in the specification, and therefore no new matter is added. Accordingly, it is respectfully submitted that the pending claims, and the application as a whole with these claims, are allowable, and a favourable reconsideration is therefore earnestly solicited.

Very respectfully,

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